

judicially created doctrine of double patenting over claims 1, 23 of U.S. Patent No. 5,555,496, claims 1, 32, 38, 45-47, 51, 68, 72, 73 of U.S. Patent No. 5,960,412, and claims 1, 11, 21, 31, 41, 45 and 49 of U.S. Patent No. 6,092,054. The Examiner further rejected claims 1-15, 18-25, 29, 31-43, 45, 50-57, 62-69, 74-80 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 5,552,994 issued to Cannon. The Examiner further rejected claim 16 under 35 U.S.C. §103(a) as being unpatentable over Cannon, claims 17, 48, 49, 60, 61, 72, 73 under 35 U.S.C. §103(a) as being unpatentable over Cannon in view of Hayes, and claims 46, 47, 58, 59, 70, 71 under 35 U.S.C. §103(a) as being unpatentable over Cannon. Applicant has cancelled claims 1-25, 28, 29, 31-43 and has provided the following arguments in support of patentability of the remaining claims 45-80.

The Examiner rejected claim 28 under 35 U.S.C. §112, second paragraph, as being dependent on a cancelled claim. Applicant has cancelled claim 28.

The Examiner rejected claims 1, 18, 29, 31, 32, 36, 45, 57, 69 under the judicially created doctrine of double patenting over claims 1, 23 of U.S. Patent No 5,555,496, claims 1, 32, 38, 45-47, 51, 68, 72, 73 of U.S. Patent No 5,960,412, and claims 1, 11, 21, 31, 41, 45 and 49 of U.S. Patent No 6,092,054, with the Examiner noting that "Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the instant application claim subject matter pertaining to system, method, means, and program code of electronically viewing, ordering, and delivering a social expression card to a recipient." Applicant has cancelled claims 1, 18, 29, 31, 32, 36.

With regard to the remaining claims 45, 57, 69, Applicant believes that the claimed subject matter is patentably distinct from the claims noted by the Examiner. In particular, each of the noted patents is discussed below.

The cited U.S. Patent No. 5,555,496 describes and claims a social expressions management system which serves a plurality of independent customers, located at remote sites that are equipped with customer terminal devices for communicating with a distribution center. The terminal device enables the customer to input, store, display and select: card recipient data, recipient occasion data, card design data, and card selection data. The terminal device processes this data to facilitate card selection and to generate a card order. The terminal device stores records of the order history and order status, card

recipient data, order history data, order status date, and recipient occasions data, which are linked to facilitate on-going management of card selection and card delivery by the customer with respect to each recipient of the customer. The terminal device is coupled by a communications link to the distribution center to permit communication of the card order to the distribution center for processing of the card order.

Claim 1 in U.S. Patent No. 5,555,496, for example, recites:

1. An electronic system for management, selection, and delivery of social expression cards directed by a plurality of independent customers wherein each customer communicates from a remote site to a distribution center, the system comprising:
 - a) a customer access terminal at each remote site having
 - 1) an input device for customer input and section of card recipient data, recipient occasion data, card design data, and card selection data,
 - 2) memory device for storage of data in the form of data records, including the card recipient data, recipient occasion data, card design data, and card selection data,
 - 3) display means for displaying textual and graphical information representative of the card recipient data, recipient occasion data, card design data, and card selection data,
 - 4) a processor coupled to the display means, memory device, and input device for processing and controlling display of the card recipient data, recipient occasion data, card design data, and card selection data to facilitate card selection and order for generating a card order responsive thereto, and for generating a storing in the memory, records of order history and order status, said card recipient data, order history data, order status date, and recipient occasions data operatively linked to facilitate on-going management of card selection and card delivery by the customer with respect to each recipient of the customer; and
 - b) a communications link coupling the customer access terminal to the distribution center to permit communication of the card order to the distribution center for processing of the card order.

Thus, the claims in U.S. Patent No. 5,555,496 do not explicitly recite the elemental concept of the present application as articulated in independent claim 45:

45. A method for initiating fulfillment of a consumer order in a system where a consumer communicates with an order fulfillment center, the method comprising the steps of:
 - storing data in at least one database, the data including a plurality of recipient data records for said customer, each of said customer's recipient data records containing data which defines a recipient;
 - linking the recipient data with social expression card data, containing

data which defines at least one social expression card, thereby forming linked data to facilitate the on-going management, selection, and delivery of social expression cards; and

providing a customer interface to permit said customer to access the data to permit said customer to initiate the delivery of social expression cards by said order fulfillment center to a plurality of said recipients.

Thus, Applicant believes that a rejection of the claims under the judicially created doctrine of double patenting using U.S. Patent No. 5,555,496 is not warranted, since claims 1, 23 contained therein do not articulate Applicant's claimed structure contained in the present application.

Similarly, the cited U.S. Patent No. 5,960,412 discloses and claims a social expressions management system which stores and links recipient data and social expression card data to facilitate the on-going management, selection, and delivery of the social expression cards. The system also provides a user interface to permit a user to access the data to permit the user to manage, select, and facilitate the delivery of the social expression cards by selecting the mode of delivery of the social expression card. This data management capability is not the subject of the claims in the present application.

Claim 1 in U.S. Patent No. 5,960,412, for example, recites:

1. A method for on-going management, selection, and delivery of social expression cards, the method comprising the steps of:
 - (a) storing data in one or more databases, the data including recipient data and social expression card data;
 - (b) linking the recipient data with the social expression card data thereby forming linked data to facilitate the on-going management, selection, and delivery of the social expression cards; and
 - (c) providing a user interface to permit a user to access the data to permit the user to manage, select, and facilitate the delivery of the social expression cards.

Thus, Applicant believes that a rejection of the claims under the judicially created doctrine of double patenting using U.S. Patent No. 5,960,412 is not warranted, since claims 1, 32, 38, 45-47, 51, 68, 72, 73 contained therein do not articulate Applicant's claimed structure contained in the present application.

Finally, the cited U.S. Patent No. 6,092,054 discloses and claims a social expressions management system which provides for the on-going management, selection,

and delivery of social expression cards and gifts to a recipient. The system stores and links recipient data and social expression card data to enable a user to manage, select, and facilitate the delivery of a social expression card to a selected recipient. The system also provides the user with a send-by-date to facilitate the delivery of a gift to said recipient in coordination with the social expression card. The use of a send-by date for an associated gift is not the subject of the claims of the present application.

Claim 1 in U.S. Patent No. 6,092,054, for example, recites:

1. A method for on-going management, selection, and delivery of social expression cards and gifts to a recipient, the method comprising the steps of:

storing data in at least one database, said data including recipient data and social expression card data;

linking said recipient data with said social expression card data, thereby forming linked data to facilitate the on-going management, selection, and delivery of a social expression card to a selected recipient;

providing a user interface to permit a user to access at least a portion of said data stored in said at least one database to permit the user to manage, select, and facilitate the delivery of a social expression card to said selected recipient; and

providing said user with a send-by-date to facilitate the delivery of a gift to said recipient in coordination with said social expression card.

Thus, Applicant believes that a rejection of the claims under the judicially created doctrine of double patenting using U.S. Patent No. 6,092,054 is not warranted, since claims 1, 11, 21, 31, 41, 45 and 49 contained therein do not articulate Applicant's claimed structure contained in the present application.

In summary, Applicant respectfully requests that the rejection of claims 45, 57, 69 under the judicially created doctrine of double patenting be withdrawn.

The Examiner rejected claims 1-15, 18-25, 29, 31-43, 45, 50-57, 62-69, 74-80 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No 5,552,994 issued to Cannon. Applicant has cancelled claims 1-25, 28, 29, 31-43, which leaves claims 45, 50-57, 62-69, 74-80 rejected under 35 U.S.C. §102(e).

The Cannon Patent discloses a kiosk-based card ordering system where the user can only order a single card for a single recipient in a single transaction. The system for printing social expression cards disclosed in the Cannon Patent consists of a personal

computer based card kiosk which enables a user to select and order a greeting card from a remotely located card printing system, using the personal computer based card kiosk to access a database of card designs. One significant limitation of this system for printing social expression cards is that it is a single transaction card purchase system that does not provide the user with the capability to store data relating to: multiple recipients, recipient addresses, recipient occasions, order history, order status. The user's transaction for the printing of a single card for a single recipient is processed and the data, input by the user relating to the recipient and the occasion, are thenceforth unavailable to the user, since the Cannon Patent fails to even hint at maintaining a database of consumer information that enables a consumer to populate a database with a plurality of recipient data records. Thus, the focus of the Cannon system is to print a single social expression card for a single recipient via a transaction-based public kiosk, with all of the data input by the user being transient in nature.

In contrast, Applicant's social expressions management system enables a consumer to populate a database with a plurality of recipient data records, then link the recipient data with social expression card data to facilitate the on-going management, selection, and delivery of social expression cards. The consumer has the ability "to access the data to permit said customer to initiate the delivery of social expression cards by said order fulfillment center to a plurality of said recipients." Thus, the consumer can execute a transaction that addresses the social expressions needs for a plurality of recipients and a plurality of occasions, with Applicant's system maintaining a database to reflect the complex nature of the consumer's social expression needs and to facilitate the on-going management, selection, and delivery of social expression cards. This ability to store a plurality of recipient data records, then link the recipient data with social expression card data to facilitate the on-going management, selection, and delivery of social expression cards to facilitate the on-going management, selection, and delivery of social expression cards and enable the consumer to order social expression cards for a plurality of recipients is not even hinted at by the Cannon Patent, yet is specifically recited in Applicant's independent claim 45, for example:

45. A method for initiating fulfillment of a consumer order in a system where a consumer communicates with an order fulfillment center, the

method comprising the steps of:

- storing data in at least one database, the data including a plurality of recipient data records for said customer, each of said customer's recipient data records containing data which defines a recipient;

- linking the recipient data with social expression card data, containing data which defines at least one social expression card, thereby forming linked data to facilitate the on-going management, selection, and delivery of social expression cards; and

- providing a customer interface to permit said customer to access the data to permit said customer to initiate the delivery of social expression cards by said order fulfillment center to a plurality of said recipients.

Thus, Applicant believes that independent claim 45 and its dependent claims 46-56 are allowable under 35 U.S.C. §102(e) over U.S. Patent No 5,552,994 issued to Cannon. Similarly, Applicant believes that independent claims 57, 69 and their respective dependent claims 58-68 and 70-80 are also allowable under 35 U.S.C. §102(e) over U.S. Patent No 5,552,994 issued to Cannon for the reasons noted with respect to claim 45.

The Examiner further rejected claim 16 under 35 U.S.C. §103(a) as being unpatentable over Cannon, claims 17, 48, 49, 60, 61, 72, 73 under 35 U.S.C. §103(a) as being unpatentable over Cannon in view of Hayes, and claims 46, 47, 58, 59, 70, 71 under 35 U.S.C. §103(a) as being unpatentable over Cannon. Applicant has cancelled claims 16, 17 and believes that claims 46-49, 58-61, 70-73 are allowable under 35 U.S.C. §103(a) since they depend on allowable base claims as well as being allowable over the cited Cannon Patent individually as well as in view of the cited Hayes reference, since these references fail to even hint at Applicant's claimed ability to store a plurality of recipient data records, then link the recipient data with social expression card data to facilitate the on-going management, selection, and delivery of social expression cards and to also enable the consumer to order social expression cards for a plurality of recipients.

In summary, Applicant believes that claims 45-80 are allowable under the judicially created doctrine of double patenting over the cited references, under 35 U.S.C. §102(e) over the cited Cannon reference, and under 35 U.S.C. §103(a) over the cited Cannon and Hayes references.

Applicant respectfully requests that the Examiner reconsider the present rejection of Applicant's claims 45-80 and that a Notice of Allowance be issued in a timely manner. If

VERSION WITH MARKINGS TO SHOW CHANGES MADE

In the Claims:

Cancel Claims 1-25, 28, 29, 31-43.

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the Examiner believes that any further issues need to be addressed, or has proposed clarifications to the claims, the undersigned is available at the convenience of the Examiner for a telephone interview to address these issues.

It is believed that no fees are due at this time; however, Applicants authorize the Commissioner to charge any additionally required fees to deposit account #50-1848.

Respectfully submitted,
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